

Remarks

The Office Action mailed December 23, 2010 has been received and reviewed. Claims 1, 4 and 20 have been amended, no claims have been canceled, and new claims 35-40 are presented. Upon entry of the amendments presented herein, claims 1, 3-6, and 8-40 will be pending. Reconsideration and withdrawal of the rejections are respectfully requested.

Claim Amendments

Support for the amendments to claims 1 and 20 can be found in, e.g., original claim 1 and in paragraph [0023] of the specification (wherein illustrative connections between the conductors and the sensor are discussed).

Support for new claims 35, 36, 38, and 39 can be found in the application as filed at, e.g., paragraph [0029] (on page 10) and Figure 6B.

Support for new claims 37 and 40 can be found in, e.g., original claim 2.

Entry and consideration of these amendments are respectfully requested.

The 35 U.S.C. §102 Rejection

Claims 1, 3-6, and 8-34 were rejected under 35 U.S.C. §102(b) as anticipated by Halperin et al. (U.S. Patent No. 5,564,434). Applicants respectfully traverse this rejection and the assertions made in support of it.

Both of independent claims 1 and 20 recite a medical electrical lead that includes, *inter alia*, a cable conductor located within a separate coil conductor. Further, the cable conductors include a "a plurality of wire strands forming a multilayered, conductive bundle that comprises an outer layer comprising multiple wire strands located around an inner layer that comprises multiple wire strands."

Halperin teaches a medical electrical lead with an inner conductor 16 located within an outer coil conductor 14. What Halperin does not teach, however, is an inner conductor 16 with multiple wire strands in an inner layer and multiple wire strands in an outer layer located around the inner layer. It is, in fact, admitted on page 3 of the Office Action that Halperin does not

disclose all of the features recited in independent claims 1 and 20 ("Halperin discloses the device substantially as claimed except for the conduct (*sic*) having an inner and outer coil created from a plurality of wire strands.").

Because Halperin does not disclose all of the features recited in independent claims 1 and 20 (and their respective dependent claims), Applicants respectfully submit that Halperin does not support an anticipation rejection of claims 1, 3-6, and 8-34.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the anticipation rejection of claims 1, 3-6, and 8-34 over Halperin.

The 35 U.S.C. §103 Rejection

Claims 1, 3-6, and 8-34 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Halperin et al. (U.S. Patent No. 5,564,434) in view of Anderson et al. (U.S. Patent No. 4,552,432). Applicants respectfully traverse this rejection and the assertions made in support of it.

In support of this obviousness rejection it is asserted that one of ordinary skill in the art would have substituted the cable of Anderson et al. for the coiled inner conductor 16 of Halperin. Applicants respectfully submit, however, that the asserted obviousness rejection of claims 1, 3-6, and 8-34 does not meet the requirements for a *prima facie* case of obviousness.

Among the reasons for Applicants' position that a *prima facie* case of obviousness has not been established is that the proposed modification would render the medical electrical lead of Halperin unsuitable for its intended purpose. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *See, e.g.,* MPEP § 2143.01(V) (*quoting In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

The inner coiled conductor 16 of Halperin, in addition to carrying electrical signals, also defines a stylet receiving lumen as discussed in the following excerpt from column 7 of Halperin:

Serial No.: 10/759,997

Confirmation No.: 8682

Filed: January 16, 2004

For: NOVEL IMPLANTABLE LEAD INCLUDING SENSOR

pressure sensor module 20. A stylet receiving lumen is formed within the inner coiled wire lead conductor 16 and extends to the connection with the sensor module 20. 30

The in-line connector assembly 30 includes an inner connector pin 36 having a stylet receiving, pin lumen 38 and is attached to the proximal end of the inner coiled wire conductor 16 to align the pin lumen 38 with the stylet receiving lumen of the inner coiled wire conductor 16. An 35

As discussed in the excerpt reproduced above, the stylet receiving lumen within the conductor 16 is aligned with the pin lumen 38 in the connector assembly 30. These features can be seen in Figures 2 and 3 of Halperin as reproduced below:

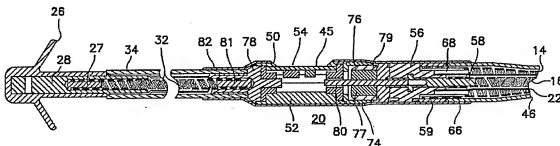


FIG. 2

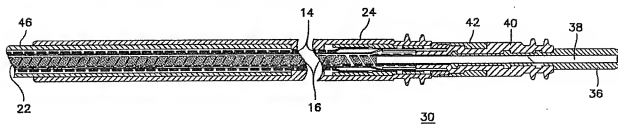
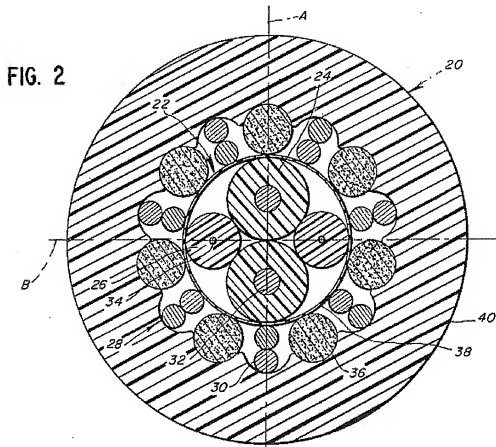


FIG. 3

Applicants respectfully submit that, if the coiled conductor 16 of Halperin were replaced by the cable of Anderson et al. as proposed in support of this obviousness rejection, the conductor 16 would not include a stylet receiving lumen and would, therefore, be unable to accept a stylet for proper use of the medical electrical lead. No stylet receiving lumen would be

provided because the construction of the cable taught in Anderson et al. includes no lumen as seen in, e.g., Figure 2 of Anderson et al. as reproduced below.



In other words, the proposed modification to replace the coiled conductor 16 of Halperin (which includes a stylet receiving lumen) with the cable conductor of Anderson et al. would yield a medical electrical lead with no stylet receiving lumen, thereby rendering the medical electrical lead of Halperin unsuitable for its intended purpose.

Furthermore, the cable of Anderson et al. is described as a "hybrid cable" that includes conductors for both optical and electrical connections. In particular, the central section 22 of the

cable (including at least one optical conductor 26 and "strength members" 24) is not electrically connected to any other components. *See, e.g., Anderson et al.*, column 2, line 65 to column 3, line 14. In fact, the central section 22 of the cable includes only components for optical connections and components to increase the strength of the cable (to protect the lower strength optical conductor 26).

In contrast, independent claims 1 and 20 recite that both the outer coil conductor and the inner cable conductor are electrically connected to the sensor capsule.

As a result, Applicants respectfully submit that one of ordinary skill in the art would not be motivated to use the teachings of Anderson et al. to modify the medical electrical lead of Halperin because to do so would require a change in the function of the cables taught in Anderson et al. "A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art." M.P.E.P. §2143(A) (citing *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1395 (2007)) (emphasis added). In view of the above, Applicants respectfully submit that modifying the function of the cables taught by Anderson et al. is impermissible to establish a *prima facie* case of obviousness.

For at least the reasons presented herein, Applicants respectfully submit that the combination of Halperin in view of Anderson et al. does not support a *prima facie* case of obviousness. Reconsideration and withdrawal of the obviousness rejection of claims 1, 3-6, and 8-34 are, therefore, respectfully requested.

Serial No.: 10/759,997

Confirmation No.: 8682

Filed: January 16, 2004

For: NOVEL IMPLANTABLE LEAD INCLUDING SENSOR

Summary

It is respectfully submitted that claims 1, 3-6, and 8-40 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives at the telephone number listed below if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

By

Mueeting, Raasch & Gebhardt, P.A.

P.O. Box 581336

Minneapolis, MN 55458-1336

Phone: (612) 305-1220

Facsimile: (612) 305-1228

Customer Number 26813

25 APRIL 2011
Date

By: KWR

Kevin W. Raasch

Reg. No. 35,651

Direct Dial (612) 305-1218

CERTIFICATE UNDER 37 C.F.R. §1.8:

The undersigned hereby certifies that this paper is being transmitted via the U.S. Patent and Trademark Office electronic filing system in accordance with 37 C.F.R. §1.6(a)(4) to the Patent and Trademark Office addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 25th day of April, 2011.

By: Deb Schumann

Name: Deb Schumann
